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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,193	09/20/2001	Bulent M. Basol	042496 0269244	4599
27498	7590	09/29/2004	EXAMINER	
PILLSBURY WINTHROP LLP 2475 HANOVER STREET PALO ALTO, CA 94304-1114			WONG, EDNA	
			ART UNIT	PAPER NUMBER

1753

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/961,193

Applicant(s)

BASOL, BULENT M.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004 and 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2004 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-33** are rejected under the judicially created doctrine of double patenting over claims 1-30 of U. S. Patent No. 6,534,116 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 1 of the instant application recites:

*A method of plating a conductive top surface of a workpiece, the conductive top surface of the workpiece including a top portion and a cavity portion, the method comprising the steps of:*

*applying, over the conductive top surface of the workpiece, an electrolyte solution with at least one additive disposed therein, wherein a first portion of the additive becomes adsorbed on the top portion and a second portion of the additive becomes adsorbed on the cavity portion;*

*using a workpiece-surface-influencing device to make physical contact with the top portion and establishing relative movement with the workpiece to change at least the first portion of the additive absorbed onto the top portion;*

*moving the workpiece-surface-influencing device away from the workpiece surface so that the physical contact between the workpiece-surface-influencing device and the workpiece no longer occurs; and*

*plating the conductive top surface of the workpiece with a conductor obtained from the electrolyte solution at least during a period of time when at least some of the changed is maintained and while the workpiece-surface-influencing device remains moved away from the workpiece surface, thereby causing greater plating of the cavity portion relative to the top portion.*

Claim 1 of the patent recites:

*A method of plating a conductive top surface of a workpiece, the conductive top surface of the workpiece including a top portion and a cavity portion, the method comprising the steps of:*

*applying, over the conductive top surface of the workpiece, an electrolyte solution with at least one additive disposed therein, wherein a first amount of the additive becomes adsorbed on the top portion and a second amount of the additive becomes adsorbed on the cavity portion;*

*applying an external influence to the top portion, the external influence removing from the top portion of the workpiece a part of the first amount of the additive previously adsorbed on the top portion; and*

*plating the conductive top surface of the workpiece before the additive fully re-adsorbs onto the top portion, thereby causing greater plating of the cavity portion relative to the top portion.*

The difference between claim 1 of the instant application and claim 1 of the patent is that claim 1 of the instant application recites:

using a workpiece-surface-influencing device to make physical contact with the top portion and establishing relative movement with the workpiece to change at least the first portion of the additive absorbed onto the top portion; and

moving the workpiece-surface-influencing device away from the workpiece surface so that the physical contact between the workpiece-surface-influencing device and the workpiece no longer occurs.

However, these limitations are an obvious variant of at least claims 1-3 of the patent because the invention of claims 1-3 of the patent is:

applying an external influence to the top portion, the external influence removing from the top portion of the workpiece a part of the first amount of the additive previously adsorbed on the top portion,

wherein the step of applying the external influence (= a workpiece-surface-influencing device) uses a movable mask (= establishing relative movement with the workpiece) applied over the conductive top surface of the workpiece to physically sweep (= moving the workpiece-surface-influence device away from the workpiece surface) the first amount of the additive adsorbed on the top portion, thereby reducing the amount of the additive adsorbed on the top portion for a period of time (= to change at least a portion of the first portion of the additive absorbed onto the top portion),

wherein the movable mask in the step of applying the external influence makes a physical contact with the top portion of the workpiece (= to make physical contact with the top portion).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Response to Arguments***

#### **Terminal Disclaimer**

The terminal disclaimer filed on July 19, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,534,116 has been reviewed and is NOT accepted.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

#### **Non-Compliant Amendment**

The status identifier "(Previously Presented)" in claims 1, 4, 8-10, 14, 19-20, 24, 26-27 and 33 is not one of the seven status identifiers allowed for a claim. See the

memo of "Revised Amendment Practice: 37 CFR 1.121: Changed Compliance is Mandatory" attached herewith.

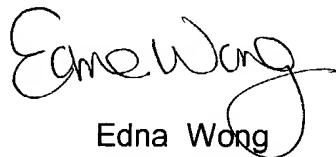
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 3:30 pm, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Edna Wong". The signature is fluid and cursive, with the first name "Edna" and last name "Wong" clearly distinguishable.

Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
September 25, 2004